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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,796	02/17/2005	Detlef Baasch	ZAHFRI P713US	8335
20210	7590	11/15/2006	EXAMINER	
DAVIS & BUJOLD, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301			HOLMES, JUSTIN K	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/524,796

Applicant(s)

BAASCH ET AL.

Examiner

Justin K. Holmes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/17/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Examiner acknowledges receipt of the Preliminary Amendment filed on February 17, 2005. Claims 1-9 have been cancelled and claims 10-18 are currently pending.

Specification

2. The amendments to the specification as set forth in the Preliminary Amendment filed on February 17, 2005 have been entered.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required

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feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation "a vehicle", and the claim also recites "especially an all-terrain vehicle" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,522,777 to Baxter et al. in view of U.S. Publication No. 2003/0228954 to Runde et al.

Regarding claims 10, and 13-15, the Baxter et al. patent teaches a method for controlling a drivetrain in a vehicle with a motor 28, a multi-range transmission and an output means, a control apparatus 50, 110, the multi-range transmission 26 consisting at least of an automatic transmission 26 and a downstream range group 25 that can be shifted by means of shift elements 68, 96, when a transmission range of the range group 25 is changed, a first shift element 68 of the range group 25 is closed and the openable shift element 74 is synchronized and opened by controlling shift elements of the automatic transmission 26. See Figs. 1 and 2, and column 2, lines 7-13; column 5, lines 49-53. A change in the range group 25 and the automatic transmission 26 is

smaller than if the automatic transmission 26 had been changed alone. See the chart in column 7 and first gear high and third gear low.

However, the Baxter et al. patent lacks a teaching of changing the transfer capability of at least one shifting element of the automatic transmission in order to change the speed of rotation of the motor.

The Runde et al. publication teaches an automatic transmission 14 connected to an engine 12 and a transfer case 21. The automatic transmission 14 has shift elements c1-c5 that are modulated by valves 62, 64 so that their degree of engagement can be changed as necessary. See page 2, paragraphs 0017-0019. The term slipping state as broadly recited in the claims is defined as the modulation of the shift elements c1-c5. The rotation of the engine 12 is achieved by a change of a transfer capability of at least one shifting element, namely, clutch c3 and clutch c5, to one of equivalent connective speed of rotation ratio of the multi-group transmission 14 at which the closable shifting element of the range group is synchronized. See page 3, paragraph 21.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Baxter et al. patent to include the automatic transmission as taught in the Runde et al. publication in order to provide for optimized sequential downshifting and skip shifting. See the abstract of the Runde et al. publication.

Regarding claim 16, the change in ratio of the range group 25 and the automatic transmission 26 take place automatically when a defined operating condition exists, namely, the control module 110 does not allow the range group 25 or the automatic

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transmission 26 to shift unless an over revving situation is avoided. See column 5, lines 27-62 of the Baxter et al. patent.

Regarding claim 17, the range change takes place in the range group 25 in response to a voluntary driver command, namely, a shift button. See column 5, lines 65-67 and column 6, lines 1-5 of the Baxter et al. patent.

Regarding claim 18, the control device is composed of a motor torque control device 110, automatic transmission control device and range group device 50 are communicatively bound to one another and exchange signals. See column 4, lines 65-67 and column 5, lines 7-27.

Allowable Subject Matter

8. Claims 11 and 12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,588,935 to Osinski et al.; U.S. Publication No. 2002/0088291 to Bowen; U.S. Publication No. 2004/0220007 to Pelchen et al.; U.S. Publication No. 2004/0220009 to Yu et al. all teach various transfer cases and control methods.

Facsimile Transmission

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time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on _____ (Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin K. Holmes whose telephone number is (571) 272-5930. The examiner can normally be reached on 8:00am to 4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on (571) 272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JKH

11/13/06


HAHO
PRIMARY EXAMINER

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